

**REMARKS**

Claims 1-13 are all the claims pending in the application.

**1. Claim Rejections Under 35 U.S.C. § 112**

The Examiner has rejected claims 1-13 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Applicants traverse the rejection.

With respect to claims 1-12, the Examiner contends that the specification requires that the angle zero not be excluded from the claims because at an angle of  $30^\circ$  for  $\alpha$  or  $\beta$ , the other angle must be zero in order to maintain a  $\Delta C/N$  that is -6 db or greater. Office Action at pages 5 and 6.

Applicants disagree because none of the claims recite the -6 db limitation nor does the Specification indicate that the -6 db feature is critical. The Examiner's attempt to import this limitation from the Specification when construing the claims is clearly improper under the MPEP and current case law. See MPEP at 2100-9 and *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (“[L]imitations are not to be read into the claims from the specification.”).

However, for the purposes of expediting prosecution, Applicants have amended claims 1 and 4 to recite that  $0 \leq \alpha < 30^\circ$  or  $-30^\circ < \alpha \leq 0$ . Applicants request entry of this amendment as a matter of right since the present §112, first paragraph, rejection is a new rejection. Although claims 1-12 were rejected under 35 U.S.C. § 112, first paragraph, in the Office Action of June 13, 2005, the contentions of the Examiner in the June 13 Office Action relate to “new matter” issues.

In the present Office Action, the Examiner's contentions in the response to arguments section relate to the newly introduced issue of an alleged “critical” feature not being claimed, i.e., the zero angle is critical and must be included. Applicants submit that this is a different

issue from that presented in the earlier Office Action, and the amendments to claims 1 and 4 must be entered as a matter of right.

In addition, the Examiner's contentions with respect to the § 112 rejection are not relevant to the subject matter of claims 2 and 3 (and their respective dependent claims). Claims 2 and 3 do not exclude zero for angle  $\alpha$  and also do not recite a range for  $\alpha$ , thus,  $\alpha$  may be zero when  $\beta$  is  $30^\circ$ . Therefore, Applicants submit that the Examiner's contentions do not support the §112 rejections of claims 2, 3, 6, 7, 10 and 11.

With respect to claim 13, Applicants submit that the Specification, at a minimum, implicitly provides support for the limitation that the magnetic generating device is rotatably mounted on the magnetic transfer apparatus such that the application angles  $\alpha$  and  $\beta$  are adjustable within a range of  $\pm 30^\circ$ . The Specification discloses that after the transferring magnetic field is applied by the magnetic field generating means, the slave medium 2 and master medium 3 are rotated to transfer the information from the master to the slave (Specification at page 10, lines 7-11). In the next sentence, the Specification discloses that the magnetic field generating means 5 is preferably rotatably mounted (page 10, lines 12 and 13).

Applicants submit that, in the context of this disclosure, the rotation of the magnetic field generating means would have to refer to the angle of the transferring magnetic field, not the rotation to produce the transfer of information since the slave and master are rotated to perform the transfer of information. In addition, the Specification discloses that the transferring magnetic field is applied at angles  $\alpha$  and  $\beta$  that may range from  $\pm 30^\circ$ , respectively (see at least Specification at page 10, line 24, to page 11, line 13). Therefore, based on these disclosures, Applicants submit that the Specification provides at least implicit support to one skilled in the art

to practice and use the invention as set forth in claim 13. The MPEP is clear in that the disclosure to support claim language may be express, implicit or inherent. See MPEP at 2100-9.

**2. Claim Rejections Under 35 U.S.C. § 103**

The Examiner has rejected claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,570,724 to Komatsu et al. (“Komatsu”). For at least the following reasons, Applicants traverse the rejection.

Claim 1 describes a magnetic transfer method “wherein an application angle  $\beta$  of the transferring magnetic field is  $0 < \beta \leq 30^\circ$  or  $-30^\circ \leq \beta < 0$  with respect to the track direction on a plane parallel to the slave surface.” The Examiner concedes that Komatsu does not disclose this feature, but contends that the optimal working range would only involve routine skill in the art. Office Action at page 4.

Applicants submit that the cited reference does not expressly disclose angles  $\alpha$  and  $\beta$ , the angle  $\theta$  described in Komatsu is an inclination angle corresponding to a magnet, not necessarily the claimed angles. In addition, the claimed variance of  $\beta$ , which includes the angles less than zero, is not disclosed.

In the present invention, as set forth in claim 1, by setting the device at the claimed  $\alpha$  and  $\beta$  angles, the robustness of the device is improved. Generally, not only is there a pattern along the track direction, but also an inclined pattern. The present invention obtains a high-definition signal by setting an angle of the applied magnetic field to be less than  $30^\circ$  with regard to all patterns.

As even the Examiner concedes, Komatsu is silent regarding a variation in the application angle  $\beta$  with respect to the track direction on a plane parallel to the slave surface. Office Action

at pages 4 and 5. Accordingly, Komatsu does not disclose or even remotely suggest that varying the transfer magnetic field with respect to a track direction on a plane parallel to the slave surface will achieve a recognizable result.

The MPEP clearly states that a “particular parameter must first be recognized as a results-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” MPEP at 2100-149. Because Komatsu does not disclose that varying an application angle with respect to the track direction on a plane parallel to the slave surface will achieve a recognizable result, Applicants submit that the Examiner has not made a *prima facie* case of obviousness.

Because independent claims 2-4 and 13 recite varying their respective application angles  $\beta$  and because the Examiner’s rejection of these features is similar to that given above with respect to claim 1, Applicants submit that the Examiner has failed to make a *prima facie* case of obviousness for at least reasons similar to those given above with respect to claim 1.

Applicants submit that claims 5-12 are patentable at least by virtue of their respective dependencies.

### **3. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

**Amendment under 37 C.F.R. § 1.116**  
**U.S. Serial No. 10/078,635**

**Attorney Docket No.: Q68390**

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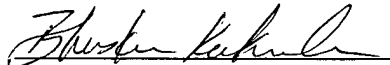
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**23373**

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